

ATTORNEY DOCKET NO. 21085.0143U2
Application No. 10/712,447

REMARKS

The PTO requires the restriction of the claims in the above-identified application into one of the following five groups of claims. Group I includes claims 1-8 and 14-17, which are drawn to peptides and compositions; Group II includes claims 10-13 and 26-27, which are drawn to nucleic acids, vectors and host cells; Group III includes claim 18, which is drawn to a monoclonal antibody; Group IV includes claims 19-25 and 31-34, which are drawn to methods comprising contacting a polypeptide with a cell or administering a polypeptide to a subject; and Group V includes claims 28-30, which are drawn to transgenic non-human subjects.

In response, Applicant elects Group I, claims 1-8 and 14-17 with traverse. Applicant respectfully requests that the restriction requirement be reconsidered, as the Examiner has not shown that a serious burden would result if all the claims are examined together. M.P.E.P. § 803 provides that "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (*Emphasis added.*) Thus, for a restriction requirement to be proper, the Examiner must satisfy the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. § 121) and (2) the search and examination of the entire application cannot be made without serious burden. *See* M.P.E.P. § 803. Applicant notes that the restriction requirement does not provide sufficient basis to indicate that examination of more than one of the "groups" would overly burden the Examiner. Applicant thus respectfully requests reconsideration of the election requirement.

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In addition, the PTO notes that claim 1 recites multiple protein sequences, and requires that the Applicant elect a single one of the sequences. In response, Applicant elects SEQ ID NO: 210 as reflected in the amended claims.

The Office Action also divides claims 4 and 5 of Group I into two hundred and seven species and requires election of a single species from the group.

In response, Applicants elect SEQ ID NO: 5 with traverse. Applicant respectfully requests that the requirement for species election be reconsidered, as the Examiner has not shown that a serious burden would result if all the species are examined together. M.P.E.P. § 803 provides that “[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” (*Emphasis added.*) Thus, for a restriction requirement to be proper, the Examiner must satisfy the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. § 121) and (2) the search and examination of the entire application cannot be made without serious burden. *See* M.P.E.P. § 803. Applicant notes that the restriction requirement does not provide sufficient basis to indicate that examination of more than one of the “species” would overly burden the Examiner. Applicant thus respectfully requests reconsideration of the election requirement. In addition, as each of the species listed in claims 4 and 5 properly fall within the elected genus (see above), Applicant reminds the Examiner that if the elected genus is found to be allowable, all of the species listed in claims 4 and 5 should also be found allowable.

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The Office Action also divides claims 32-34 of Group IV into eleven species and requires election of a single species from the group. Applicants have not elected Group IV for prosecution on the merits, therefore Applicants submit that the requirement of this species election is moot.

The Office Action states that the claims of Group I and IV are related as product and process of use and are distinct because the products as claimed can be used in a materially different process, such as in making antibodies. The MPEP § 821.04 states that where an applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined as a matter of right, so long as the process claims that depend from or otherwise include all the limitations of the patentable product. Applicants, by choosing the product claims of Group I, and because the product claims of Group 4 depend from or otherwise include all the limitations of the claims of Group I, hereby remind the Examiner that Group IV should be rejoined upon allowance of the claims of Group I.

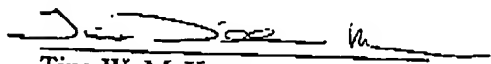
In addition, the amendments to the claims presented above are being made without prejudice to filing a continuation application directed to the non-elected subject matter.

No fee is believed to be due with this submission; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

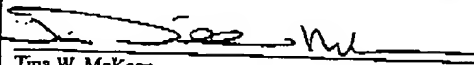
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Respectfully submitted,

NEEDLE & ROSENBERG, P.C.


Tina W. McKeon
Registration No. 43,791

NEEDLE & ROSENBERG, P.C.
Customer Number 23859
(678) 420-9300
(678) 420-9301 (fax)

<u>CERTIFICATE OF FACSIMILE TRANSMISSION UNDER 37 C.F.R. § 1.8</u>	
I hereby certify that this correspondence, including any items indicated as attached or included, is being transmitted via facsimile transmission to: Examiner Daniel E. Kolker, at 571 273 8300 on the date indicated below.	
 Tina W. McKeon	<u>March 16, 2006</u> Date